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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/069,159 | 06/06/2002 | Heinrich Francke | 18584-0003 | 1888 |
| 7590 | 03/19/2004 | | EXAMINER | |
| Sutherland Asbill & Brennan 999 Peachtree Street NE Atlanta, GA 30309-3996 | | | KUMAR, PREETI | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1751 | |
| DATE MAILED: 03/19/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/069,159 | FRANCKE ET AL. |
| | Examiner Preeti Kumar | Art Unit 1751 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 June 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5-6.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Non-Final Rejection

1. Claims 1-5 are pending.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

3. Claim 5 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-4 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically regarding claims 1-4, the phrase "characterized in that" and the phrase "and/or" render the claims indefinite because it is unclear whether the limitation(s) following the phrases are part of the claimed invention.

Claim 2, recites the limitation "the iodine number" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

Specifically regarding claim 4, the limitation of "... 1-10% of a substance..." is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The court has held that compositions are indefinite for being defined in terms of properties alone. *Ex parte Spacht*, 165 USPQ 409 (PO BdPatApp 1969); *Ex parte Slob.*, 157 USPQ 172 (PO BdPatApp 1967); *Ex parte Pulvari*, 157 USPQ (PO BdPatApp 1966);

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1, 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hopkins et al. (US 4,560,386).

Hopkins et al. teach a method for dyeing skins in a single bath and in one step. The dyeing is carried out with reactive dyestuffs bearing at least one reactive group selected from acryloylimino, halogenoacryloylimino and .beta.-halogenopropionylimino, in the presence of non-ionic or anionically modified polyalkoxylated surfactants. See abstract. The one-bath dyeing process for the suede or leather and the fur wool or hair to be dyed tone-in-tone presents a difficult problem since the wool or hair on one side and the leather on the other side possess different dyeing properties due to their differing protein structures. However, Hopkins et al. illustrate by example, a single bath comprising a lubricant, retanning agent, substances regulating the pH and further additives in the same proportions as recited by the instant claims. See example 1 where Hopkins et al. illustrate a one-bath method for producing dyed skins, wherein the aqueous bath of 2000 parts contains 2 parts sodium carbonate, 1 part of an agent having affinity for fibres based on a sodium aromatic sulphonic acid salt and 1 part of a mixture of surfactants and formaldehyde. After a treatment time of 30-60 minutes, there are further added 2 parts of an agent having affinity for dyes and based on an addition product of 10 mols ethylene oxide on an alkyl (C._{sub}.12) amine and 4 parts of the reaction product of chloroacetic acid with tetramethylnonylhexapolyglycol ether. The shearling suede is further treated for 15 minutes and then 2 parts of a weakly anionic fat liquoring agent. Dyeing is effected for 30 to 60 minutes followed by a fixation treatment with 1-6 parts formic acid 85% for 30-60 minutes in the same bath at the constant

temperature of 60.degree. Accordingly, the broad teachings of Hopkins et al. appear to anticipate the material limitations of the instant claims.

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkins et al. (US 4,560,386).

Hopkins et al. are relied upon as set forth above.

However, Hopkins et al. are silent as to the reduction in iodine number after oxidation treatment as recited by the instant claim.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a liquid agent for oxidative treatment that would reduce iodine number as recited by the instant claims, with a reasonable expectation of success, because the teachings of Hopkins et al. illustrate an oxidative reduction treatment process for treating leather with an analogous liquid agent.

11. Claims 1,3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Covington (US 4,937,009).

Covington teaches a leather tanning process in which animal skins are treated with a tanning agent and a salt of a polyhydroxymonocarboxylic acid. See abstract and col.2, ln.50-60. Covington teaches a typical procedure for solo tanning comprising pretreating the rawstock for tannage in the normal way; adjusting rawstock to pH 4-5; adding tanning complex; adding fatliquor; agitating to promote diffusion of the tanning components into the pelt; and draining and complete processing in the normal way. See col.4, ln.5-15 and col.4, ln.30-40.

Covington teaches by example animal skin treated in an aqueous bath comprising a lubricant, retanning agent and other additives in proportions encompassed by the material limitations of the instant claims. See examples 1 and 15 where Covington illustrates an aqueous bath for treating snake skin (70 g) depickled to pH 4.5 comprising sodium bicarbonate, 30 g fatliquor/l and 20 g Al.₂O.₃/+10 g TiO₂/l (described in Example 1). After rinsing, toggle drying and staking, the shrinkage temperature was 79.degree. C. Accordingly, the broad teachings of Covington appear to anticipate the material limitations of the instant claims.

12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Covington (US 4,937,009).

Covington is relied upon as set forth above. However, Covington is silent as to the reduction in iodine number after oxidation treatment as recited by the instant claim.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a liquid agent for oxidative treatment that would reduce iodine number as recited by the instant claims, with a reasonable expectation of success, because the teachings of Covington illustrate an oxidative reduction treatment process for treating leather with an analogous liquid agent.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

Art Unit: 1751

14. Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Preeti Kumar whose telephone number is 571-272-1320. The examiner can normally be reached on M-F 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra N. Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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Preeti Kumar
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Art Unit 1751

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